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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/653,706 | 09/01/2000 | Gilberto Arnaiz | SIEB012/01US | 5924 |
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| PERKINS COIE LLP | | | WOOD, WILLIAM H | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|---------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/653,706 | ARNAIZ ET AL. |
| | Examiner | Art Unit |
| | William H. Wood | 2124 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 53-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 53-60 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 53-60 are pending and have been examined.

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 120 based upon an application filed in US on 3 March 1999.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 53-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims contain amended limitation "interrogating other installed software on that client computer to determine the versions of those not-up-to-date software components that are installed on that client computer". This limitation is worded differently than the previous original version. It now seems to state other software on the client provides the version of the not-up-to-date components on the client. Yet, if the updating method was able to determine the component wasn't up-to-date, why can't it determine the version as well. This arrangement is not previously disclosed in the originally filed specification in such a manner as to convey that the

inventor(s) had possession of the claimed invention. The previously written claim language was broader than the current version and did not require this interpretation. For rejection purposes below, the limitation is interpreted as reading “interrogating other installed software on that client computer to determine affected dependent software components that are installed on that client computer” (support found on specification page 20, lines 15+). Appropriate correction required.

The claim 56 includes the limitation “downloading one or more upgrade kits ... before *it has been determined* that the client computer requires upgrades”. It is unclear how one of ordinary skill in the art at the time of invention would know to download something *before determining* it is needed to download. Furthermore, this was not disclosed in the originally filed specification in such a manner as to convey that the inventor(s) had possession of the claimed invention. For the purposes of rejection, the limitation is interpreted as follows: “downloading one or more upgrade kits for software components to a client computer before the client computer requires upgrades for those software components” (based upon limitations of claim 58). Appropriate correction required.

4. Claims 53-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims contain amended limitation “interrogating other installed software on that client computer to determine the versions of those not-up-to-date software components that are installed on that client computer”. This limitation is worded differently than the previous original version. It now seems to state other software on the client provides the version of the not-up-to-date components on the client. Yet, if the updating method was able to determine the component wasn’t up-to-date, why can’t it determine the version as well. This arrangement is not previously disclosed. Appropriate correction required.

The claim 56 includes the limitation “downloading one or more upgrade kits ... before *it has been determined* that the client computer requires upgrades”. It is unclear how one of ordinary skill in the art at the time of invention would know to download something *before determining* it is needed to download. Appropriate correction required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 53, 54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyber Media, Incorporated (EP 0 811 942 A2), herein referred to as **Cyber Media**, in view of Furtney et al. (USPN 5,579,509).

Claim 53

Cyber Media disclosed a method for a server computer to distribute and install software upgrades on client computers (*page 2, lines 5-10*), comprising:

under control of the server computer,

defining contents of software version upgrade kits of software installed on client computers, the software version upgrade kits each comprising files, actions, and an upgrade wizard to upgrade a software components from one version to another version (*page 6, lines 35-36; page 8, lines 1-3; page 9, lines 10-20, self-extracting archives that install necessary files, “self-contained”*);

writing the contents (see *page 12, line 55 to page 13, line 56*) of the software version upgrade kits to a database on the server computer as a table of contents, the table of contents showing for each of the upgrade kits the contents of that upgrade kit and any software components required for an upgrade using that upgrade kit (*page 8, lines 5-51*); and

for each of multiple client computers,

comparing the table of contents of the software version upgrade kits to software installed on that client computer to determine one or more software version upgrade kits that will each effect an upgrade on that client computer from a version of a software component currently installed on that client computer to an updated software component version (*page 6, lines 10-13*); and

building copies of the determined software upgrade kits for that client computer from the table of contents (*page 6, lines 35-36; page 8, lines 46-51; page 9, lines 1-32*); and for each of the multiple client computers,

determining whether software components for a program that is currently running on that client computer are up-to-date (*page 6, lines 6-26; checks all software, running or not*); and

when one or more software components of the program are not up-to-date,

notifying the server computer of the determined installed versions of the not-up-to-date software components on that client computer (*page 6, lines 6-13*);

downloading copies of software upgrade kits built on the server computer for that client computer to upgrade the not-up-to-date software components (*page 6, lines 35-36*);

for each of the downloaded software upgrade kits, invoking the upgrade wizard for that software upgrade kit on that client computer to upgrade one of the not-up-to-date software components on that client computer, the upgrade wizard performing the software component upgrades by performing the actions of the upgrade kit and using the files of the upgrade kit (*page 9, lines 1-32*); and

after the upgrading of the not-up-to-date software components, restarting execution of the program so as to use the upgraded software components (*page 5, line 5 to page 6, line 9; page 6, lines 49-59*).

Cyber Media did not explicitly state interrogating other installed software on that client computer to determine the version of those not-up-to-date software components that are installed on that client computer (interpreted as: interrogating other installed software on that client computer to determine affected dependent software components that are installed on that client computer). **Furtney** demonstrated that it was known at the time of invention to analyzing dependent software components (abstract; column 2, lines 30-56; and column 3, lines 30-50). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the component updating system of **Cyber Media** with interrogating for dependent components as found in **Furtney**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to provide compatible versions of components in order to ensure correct operation of a system (column 1, line 5 to column 2, line 28).

Claim 54

Cyber Media and **Furtney** disclosed the method of claim 53 including:

- ♦ before the performing of an upgrade of a software component, creating a backup of local files (*page 11, lines 21-33*);
- ♦ tracking progress of the performing of the upgrade (*page 6, lines 49-59*);
- ♦ rolling back changes made during the performing after an error occurs (*page 17, line 56 to page 18, line 27; error is simply a user who no longer wants the upgrade, dissatisfied*);
- ♦ instantiating the local file backup (*page 17, line 56 to page 18, line 27*); and

- restarting the upgrade from a save point (page 11, lines 29-30 and 38-39; *save point is that which came before installation/update).*

Claim 56

Cyber Media and **Furtney** did not explicitly disclose the method of claim 53 including downloading one or more upgrade kits for software components to a client computer before it has been determined that the client computer requires upgrades for those software components (interpreted as: downloading one or more upgrade kits for software components to a client computer before the client computer requires upgrades for those software components). **Cyber Media** demonstrated that it was known at the time of invention to provide *timely* information about available updates/upgrades (page 14, lines 1-8) as well as automated applications for installation of updates (page 14, lines 18-20). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the updating system disclosed by **Cyber Media** with downloading the updates before required (in other words, as soon as available) as suggested in **Cyber Media**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to reduce burden on the user (page 14, lines 18-20) and make sure software will remain useful (page 14, lines 1-8, *timely* notification meaning in time to use or be useful; page 5, lines 44-47, updating at predefined times).

7. Claim 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cyber Media, Incorporated** (EP 0 811 942 A2), herein referred to as **Cyber Media**, in view of **Furtney et al.** (USPN 5,579,509) in further view of **Kirouac et al.** (USPN 5,155,847).

Claim 55

Cyber Media and **Furtney** did not explicitly state the method of claim 53 comprising monitoring progress of the performing of an upgrade of a software component on a client from a server. **Kirouac** demonstrated that it was known at the time of invention to monitor progress of a client from a server (column 9, lines 34-63). It would have been obvious to one of ordinary skill in the art at the time of invention to implement **Cyber Media**'s system of updates with verification from a server as found in **Kirouac**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to prevent errors in transmission and verify results from a central administrative controlled point.

8. Claim 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cyber Media, Incorporated** (EP 0 811 942 A2), herein referred to as **Cyber Media**, in view of **Furtney et al.** (USPN 5,579,509) in further view of **Siebel Systems**, "Siebel Systems: Siebel announces production shipment of Siebel Enterprise Applications Version 3.0", herein referred to as **Siebel Systems**.

Claim 57

Cyber Media and **Furtney** did not explicitly state the method of claim 53 wherein the currently running program on the multiple client computers is database management software, and wherein the upgraded software components include database schemas.

Siebel Systems demonstrated that it was known at the time of invention to upgrade database schema (page 2, third paragraph from bottom, bold text). It would have been obvious to one of ordinary skill in the art at the time of invention to implement **Cyber Media**'s updating software with database upgrading as found in **Siebel Systems**' teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to provide updates/upgrades and installations to as many products as possible for business purposes in addition to reducing downtime (page 2, third paragraph from bottom, **Siebel Systems**).

9. Claim 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cyber Media**, Incorporated (EP 0 811 942 A2), herein referred to as **Cyber Media**, in view of **Furtney** et al. (USPN 5,579,509) in further view of Dictionary of Computing herein referred to as Computing.

Claim 58

Cyber Media disclosed the limitations of claim 58 substantially same as for claim 53 above with limitations of 57, which are incorporated herein. However, **Cyber Media** did

not teach *docking*. **Computing** demonstrated that it was known at the time of invention to dock computers (page 149). It would have been obvious to one of ordinary skill in the art at the time of invention to implement **Cyber Media**'s updating system with docking as found in **Computing**'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to expand the usefulness of the **Cyber Media** system to as many client computers as possible, including mobile ones requiring docking.

Claim 59

In regard to claim 59, the limitations correspond to the limitations of claims 54 and 56 and are rejected the same herein.

10. Claim 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cyber Media, Incorporated** (EP 0 811 942 A2), herein referred to as **Cyber Media**, in view of **Furtney et al.** (USPN 5,579,509) in further view of **Dictionary of Computing** herein referred to as **Computing** as applied to claim 58 and in further view of **Kirouac et al.** (USPN 5,155,847). The limitations correspond to the limitations of claims 55 and are rejected the same herein.

Response to Arguments

11. Applicant's arguments with respect to claims 53-60 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 02 December 2003 have been fully considered but they are not persuasive. Applicant argued prior art does not disclose i) "self-contained upgrade kits", ii) downloading kits *before* the client requires the upgrade, and iii) upgrading database schema changes when the software being upgraded is database management software. These concerns have been addressed in the revised rejections above.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (703)305-3305. The examiner can normally be reached 7:30am - 5:00pm Monday thru Thursday and 7:30am - 4:00pm every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood
February 18, 2004

Kakali Chaki
KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100